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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,014	11/29/2000	David William Cole	AUS9-2000-0489-US1	9664
35525	7590	02/24/2006	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			NAHAR, QAMRUN	
			ART UNIT	PAPER NUMBER
			2191	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/726,014		COLE ET AL.	
	Examiner		Art Unit	
	Qamrun Nahar		2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-18 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 12/09/2005.
2. Claims 1-18 are pending.
3. Claims 1-18 stand finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.
4. Claims 7-12 stand finally rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claims 1-18 stand finally rejected under 35 U.S.C. 102(e) as being anticipated by Cox (U.S. 6,856,983).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 7 and 13 substantially recite the limitation, “quantifying, using said mapping, business losses due to particular technical failures”, however, this limitation does not have sufficient support in the specification. The specification states “It is important to identify the

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metric used by the business to gauge the economic health of the business process in order to quantify the costs and benefits of implementing a solution.” on pg. 11, line 30 to pg. 12, line 1; and further states “Of absolute importance to this step is a metric to allow the quantification of business losses due to particular IT failures.” on pg. 12, lines 30-32. These are the only two sentences in the specification that describes quantifying/quantification. However, sufficient support is not provided for this limitation. That is, what is the metric and how is the business losses measured and quantified.

Furthermore, the Business System Management (BSB) configuration database is built *during the claimed mapping step*, where the mapping information is stored; and the correlation logic and rules is developed *during the claimed “developing cross-platform contextual correlation logic and rules”*. The step of “quantifying, using said mapping, business losses due to particular technical failures” is done after the claimed mapping step.

Claims 2-6, 8-12 and 14-18 are rejected for dependency upon rejected base claims 1, 7 and 13 above, respectively.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7-12, reciting a computer program product in a computer readable medium, are not limited to tangible storage devices in view of pg. 14, line 31 to pg. 15, line 4, in the instant

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specification, which suggests that such a medium may be a carrier wave or transmission medium (intangible). Accordingly, claims 7-12 do not recite tangible manufactures, and are non-statutory subject matter.

The Office's current position is that claims involving signals encoded with functional descriptive material do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. § 101, and such claims are therefore ineligible for patent protection. *See* 1300 OG 142 (November 22, 2005), in particular, see Annex IV(c).

It is suggested that claim 7 be amended to recite “a computer program product in a computer readable **storage** medium”.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Cox (U.S. 6,856,983).

Per Claim 1:

The Cox patent discloses:

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- **decomposing a business process into a set of enabling applications** (column 4, lines 3-12 and lines 26-44)
- **documenting the technology elements and support organizations which are necessary to execute and manage the enabling applications of the business process** (column 4, lines 13-25; “shoes.com” is an example of a support organization)
- **deploying required monitors for the business process enabling technology** (column 4, lines 65-67)
- **developing cross-platform contextual correlation logic and rules** (column 5, lines 3-12)
- **mapping information technology severity to business impact severity, said mapping describing how technical problems relate to business processes including said business process; quantifying, using said mapping, business losses due to particular technical failures; and developing an end-to-end business process event management platform** (column 5, lines 36-51).

Per Claim 2:

The Cox patent discloses:

- wherein the step of decomposing the business process further comprises developing an application model which describes the interactions, interdependencies and interfaces of all the business process enabling applications (column 4, lines 26-44; “business process model” is interpreted as *application model*; and further see col. 4, lines 35-40 “In FIG. 1, business process model 120 is derived from eService 105. It *dictates both how the infrastructure components should be managed by local service management systems 110 and how global eService management system integrates the information from systems 110 to assess the overall performance of infrastructure 115.*” (emphasis added), which shows that the business process model 120 describes the *interactions, interdependencies and interfaces* of all the business process enabling applications.).

Per Claim 3:

The Cox patent discloses:

- further comprising building a business system management configuration database (column 5, lines 30-35; “global data repository 770” is interpreted as *business system management configuration database*).

Per Claim 4:

The Cox patent discloses:

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- further comprising integrating the business process event management platform into a preexisting event management process (column 5, lines 44-51).

Per Claim 5:

The Cox patent discloses:

- further comprising integrating the platform at both the business and technology level through a defined input/output event management interface (column 4, lines 45-51).

Per Claim 6:

The Cox patent discloses:

- wherein the event management platform is developed across two or more separate business entities (column 4, lines 45-51).

Per Claims 7 & 8-12:

These are computer program product versions of the claimed method discussed above (claims 1-6, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Cox.

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Per Claims 13 & 14-18:

These are system versions of the claimed method discussed above (claims 1-6, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Cox.

Response to Arguments

12. Applicant's arguments filed on 12/09/2005 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

a) The rejection under 35 USC 101 is incorrect because the claims do not recite a carrier wave or transmission medium.

Examiner's response:

a) The specification describes the use of term "computer readable medium" as embracing such non-tangible embodiments as carrier waves and information transmission media. Specification, pg. 14, line 31 to pg. 15, line 4. The Office's current position is that claims involving signals encoded with functional descriptive material do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. § 101, and such claims are therefore ineligible for patent protection. *See* 1300 OG 142 (November 22, 2005), in particular, see Annex IV(c).

In addition, see the rejection above in paragraph 9 for rejection to claims 7-12.

In the remarks, the applicant argues that:

b) The examiner has failed to establish a reasonable basis to question the enablement provided for the claimed invention. There is enough support in the specification for the limitation “quantifying, using said mapping, business losses due to particular technical failures”. Applicant points to features in the specification such as Business System Management (BSB) configuration database, and correlation logic and rules.

Examiner's response:

b) The Examiner has established a reasonable basis. In support of applicant's assertion, applicant points to features in the specification such as Business System Management (BSB) configuration database, and correlation logic and rules.

First, the Business System Management (BSB) configuration database is built *during the claimed mapping step*, where the mapping information is stored.

Second, the correlation logic and rules is developed *during the claimed “developing cross-platform contextual correlation logic and rules”*.

The step of “quantifying, using said mapping, business losses due to particular technical failures” is done after the claimed mapping step.

The specification does not have enough support. In addition, see the rejection above in paragraph 7 for rejection to claims 1-18.

In the remarks, the applicant argues that:

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c) Regarding claim 1, Cox fails to teach or suggest *support organizations* in the claimed limitation “documenting the technology elements and *support organizations* which are necessary to execute and manage the enabling applications of the business process”. Cox further fails to teach or suggest “developing cross-platform contextual correlation logic and rules”.

Examiner's response:

c) Examiner strongly disagrees with applicant's assertion that Cox fails to disclose the claimed limitations recited in claim 1. Cox clearly shows each and every limitation in claim 1.

As previously pointed out in the last Office Action (Mailed on 09/09/2005, par. 13), Cox teaches documenting the technology elements and support organizations which are necessary to execute and manage the enabling applications of the business process (column 4, lines 13-25; “shoes.com” is an example of a support organization).

Furthermore, applicant has failed to point out the error in the citation provided for the claim limitation “developing cross-platform contextual correlation logic and rules”.

In addition, see the rejection above in paragraph 11 for rejection to claim 1.

In the remarks, the applicant argues that:

d) Regarding claim 2, Cox fails to teach or suggest *application model* or *interactions, interdependencies and interfaces* in the claimed limitation “wherein the step of decomposing the business process further comprises developing an *application model* which describes the *interactions, interdependencies and interfaces* of all the business process enabling applications”.

Examiner's response:

d) Examiner strongly disagrees with applicant's assertion that Cox fails to disclose the claimed limitations recited in claim 2. Cox clearly shows each and every limitation in claim 2.

As previously pointed out in the last Office Action (Mailed on 09/09/2005, par. 13), Cox teaches wherein the step of decomposing the business process further comprises developing an *application model* which describes the *interactions, interdependencies and interfaces* of all the business process enabling applications (column 4, lines 26-44; "business process model" is interpreted as *application model*; and further see col. 4, lines 35-40 "In FIG. 1, business process model 120 is derived from eService 105. It *dictates both how the infrastructure components should be managed by local service management systems 110 and how global eService management system integrates the information from systems 110 to assess the overall performance of infrastructure 115.*" (emphasis added), which shows that the business process model 120 describes the *interactions, interdependencies and interfaces* of all the business process enabling applications.)

In addition, see the rejection above in paragraph 11 for rejection to claim 2.

In the remarks, the applicant argues that:

e) Regarding claim 3, Cox fails to teach or suggest *business system management configuration database* in the claimed limitation "further comprising building a *business system management configuration database*".

Examiner's response:

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e) Examiner strongly disagrees with applicant's assertion that Cox fails to disclose the claimed limitations recited in claim 3. Cox clearly shows each and every limitation in claim 3.

As previously pointed out in the last Office Action (Mailed on 09/09/2005, par. 13), Cox teaches further comprising building a *business system management configuration database* (column 5, lines 30-35; "global data repository 770" is interpreted as *business system management configuration database*).

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, see the rejection above in paragraph 11 for rejection to claim 3.

In the remarks, the applicant argues that:

f) Regarding the remaining claims, Cox does not anticipated these claims due to dependencies on claims 1, 2 and 3.

Examiner's response:

f) The Examiner has already addressed the applicant's arguments regarding claims 1, 2 and 3 in the Examiner's Responses (c), (d) and (e) above. In addition, see the rejection above in paragraph 11 for rejection to claims 4-18.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

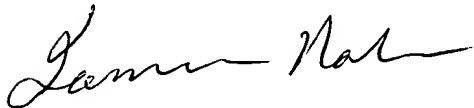
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y Zhen, can be reached on (571) 272-3708. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

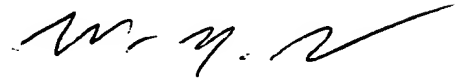
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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



QN

February 21, 2006



WEI ZHEN
SUPERVISORY PATENT EXAMINER